

are purely editorial in nature and thus would not require extensive discussion.

The Examiner has objected to the disclosure urging that it contains informalities. See page 3 of the Official Action, the last three paragraphs. Applicant respectfully submits that the amendments to the specification obviate these errors and thus the Examiner is now requested to reconsider and withdraw his objection.

Further, in regard to the specification, the Examiner, at the top of page 2 of the Official Action, refers to Applicant's prior parent application Serial No. 656,731 and states that the prior application must be referenced in the specification. The Examiner's attention is directed to the AMENDMENT presented by Applicant on August 12, 1985 at which time the specification was amended to reference the parent application and further to indicate the status of that application as being abandoned. It is believed that the Examiner has overlooked Applicants' prior amendment.

Also, in this same regard, at page 6 of the Official Action, the last paragraph, the Examiner makes a provisional double patenting rejection under the provisions of 35 U.S.C. 101. It is believed that this rejection is not appropriate in view of the fact that Applicant's parent application stands abandoned. Withdrawal of this provisional rejection is thus requested.

The claims of the application are amended by cancelling, without prejudice to the subject matter involved, original claims 1 to

28 and inserting in their stead newly formulated claims 29 to 46 inclusive. The claims as now drawn are directed to a specific aspect of the present invention supported by the disclosure particularly at pages 11 (second full paragraph) and 23 (the last full paragraph). The limitation of the claims in this manner is, of course, without prejudice to the filing of a divisional application directed to the remaining originally claimed subject matter and Applicant notes that they are concurrently filing such a divisional application.

Support for the subject matter of the claims as amended is apparent from the specification as filed and, again, particular attention is directed to pages 11 and 23 of the specification. Claim 29 is the most generic claim while claim 30 is a subgeneric claim which is dependent from claim 29. Claims 31 to 44 are directed to specific compounds falling within the scope of new claim 29 and specifically described in the specification. Particular attention is directed to original claim 12 of the application. Claim 45 is directed to an antibacterial composition while claim 46 is directed to the method for combatting bacteria. These claims correspond essentially to original claims 17 and 18 but are limited with respect to the compounds specified.

The patentability of the claims as amended will be apparent from the remarks set forth herein.

The claims were rejected by the Examiner as failing to adequately define the invention under the provisions of 35 U.S.C. 112. Applicant respectfully submits that each of the objections raised by the Examiner in the recent Official Action is overcome by

virtue of the amendments now effected. The claims as presently drawn are in direct accord with the disclosure of the application as filed as well as in direct accord with the requirements of the statute. The Examiner is thus respectfully requested to now reconsider and withdraw this ground of rejection.

Prior to delving into a discussion of the prior art rejection set forth by the Examiner, Applicant wishes to point out that the claims of the application as amended are directed to a specific group of compounds which, as revealed by the disclosure of the present application, are particularly valuable in view of the fact that they possess oral availability, i.e., they can be orally administered and are absorbed through the digestive organs. See pages 11 and 23 of the specification. These compounds are neither taught nor suggested by the teachings of the references relied upon by the Examiner in rejecting the former claims.

Rejection of the claims as being anticipated by Kinast under the provisions of 35 U.S.C. 102(e) is untenable. The Kinast reference constitutes an extremely broad generic disclosure which might be said to vaguely encompass within its broad scope the compounds being claimed herein. However, as the Examiner will surely appreciate, the Kinast reference provides no specific disclosure of the compounds of the present claims nor is there any suggestion in the Kinast disclosure to modify the compounds which are specifically disclosed therein in a manner to achieve the subject matter claimed herein. As was stated by the Court of Customs and Patent Appeals in *In re Lambooy*, 133 USPQ 270, 275:

"It is true that appellant's compound is encompassed by the broad classes of compounds disclosed by these reference patents but so are many many other compounds. We do not think that progress in the useful arts would be promoted by permitting broad theoretical disclosures as these to preclude appellant from obtaining a patent for his invention."

Thus, Applicant respectfully submits that the Examiner's rejection based upon the Kinast patent is untenable and should be withdrawn.

Likewise, a rejection of the claims as amended as lacking patentability under the provisions of 35 U.S.C. 103 over Gregory et al., Nannini et al., Kinast and Boberg et al. is deemed to be untenable. These references fail to teach or to suggest to one of ordinary skill in the art, the subject matter being claimed herein.

The Kinast reference has been discussed above. It would appear sufficient to simply point out that there is no suggestion in the teachings of this patent to modify the compounds specifically disclosed in such patent in such a way as to achieve the subject matter of the present claims.

The Gregory patent fails to provide any teaching of compounds such as those instantly claimed in which the group R is a 2-aminothiazol-4-yl moiety. The claimed compounds are thus clearly distinct from the compounds described by the Gregory patent.

The Nannini et al. disclosure is limited to compounds in which the group Z is -O- or -S-. See page 1 of the description. Such

compounds are not claimed in the present application and there is no suggestion in the Nannini et al. patent to modify those compounds in such a way as to achieve the compounds being instantly claimed.

The Boberg et al. patent fails to disclose any compounds in which the vinyl side chain of the 7-position amido group contains a carboxy group. See column 2 of the Boberg et al. disclosure. Thus, it cannot properly be said that the teachings of the Boberg et al. patent would render the instantly claimed compounds obvious to one of ordinary skill in the art.

Applicant thus respectfully submits that a rejection of the claims of the present application as lacking patentability over the above discussed references would be untenable and the Examiner is respectfully requested to reconsider and refrain from making such rejection.

Applicant respectfully submits that the present application is now in condition for allowance and such allowance is solicited.

Respectfully submitted,

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